

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/436,184 11/08/99 WANDS

J 04930/032001

EXAMINER

HM12/1019

INGRID A. BEATTIE
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND
ONE FINANCIAL CENTER
BOSTON MA 02111

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/436,184

Applicant(s)

Wands et al

Examiner

Karen Canella

Art Unit

1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 13-15, and 39-68 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 13-15, and 39-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1642

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claim 10 is amended. Claims 1-9, 11, 12 and 16-38 have been canceled. Claims 39-68 have been added. Claims 10, 13-15 and 39-68 are pending and under consideration.

Claim Rejections Withdrawn

3. The rejection of claims 10, 13 and 14 under 35 U.S.C. 102(e) as being anticipated by Radosevich (USP 6,166,176), is withdrawn.

Claim Rejections Maintained

4. The rejection of claims 10 and 13-15 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for inhibiting growth of a mammalian tumor cell in culture or a method for inhibiting a mammalian tumor cell line grown in culture, said methods comprising the administration of a HAAH antisense nucleic acid consisting of the full length antisense HAAH cDNA as well as antisense DNA corresponding to exon 1 of the HAAH gene, does not reasonably provide enablement for a method for inhibiting tumor growth in a mammal comprising the administration of a HAAH antisense nucleic acid, or the antisense nucleic acid to the 5' AAH regulatory sequence, is maintained for reasons of record. The rejection of newly added claims 39-68 is made for the same reasons of record. Applicant has provided the Declaration of Jack R. Wands to substantiate claims to the antisense nucleic directed to the 5' regulatory sequence of the AAH gene in a method for inhibiting tumor growth in a mammal. The declaration states that sequences of exemplary oligonucleotides from said 5' regulatory region consist of SEQ ID NO:10 through SEQ ID NO:13. However, the instant specification puts forth the polypeptide encoded by the AAH gene and the cDNA encoding said gene without any

Art Unit: 1642

disclosures of the specific promoter or other regulatory region 5' to the AAH gene. Further, the Sequence Listing of the instant specification does not contain any sequence above SEQ ID NO:7.

Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.
Patent Examiner, Group 1642

October 8, 2001


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600